Paper No. 23

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL S. KALISIAK et al.

Appeal No. 1997-0233
Application No. 08/266,558

ON BRIEF

Before CALVERT, STAAB, and NASE, Administrative Patent Judges.
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal from the refusal of the examiner to allow claims 1 to 3, 5 and 6. Claims 4, 7 and 8 have been allowed.

We REVERSE.

BACKGROUND

The appellants' invention relates to a vertical pressure sealing assembly. A copy of the claims under appeal is set forth in the appendix to the appellants' brief.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Edin	4,757,903	July 19, 1988
Eweryd	4,826,475	May 2, 1989
Kalisiak et al. (Kalisiak)	5,169,489	Dec. 8, 1992
Walter et al. (Walter)	5,308,436	May 3, 1994

The sole rejection before us in this appeal is[1]:

Claims 1 to 3, 5 and 6 stand rejected under 35 U.S.C. § 103 as being unpatentable over Eweryd in view of Edin, Walter and Kalisiak.

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[1] The obviousness-type double patenting rejection set forth in the examiner's answer (Paper No. 16, mailed July 27, 1996) was withdrawn in the supplemental examiner's answer (Paper No. 22, mailed May 5, 1999).

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the answer for the examiner's complete reasoning in support of the rejection, and to the brief (Paper No. 15, filed June 4, 1996) and reply brief (Paper No. 17, filed August 27, 1996) for the appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 to 3, 5 and 6 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that would have led one of ordinary skill in the art to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). When it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain
whether there is any suggestion or motivation in the prior art to make the selection made by the appellants. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination. The extent to which such suggestion must be explicit in, or may be fairly inferred from, the references, is decided on the facts of each case, in light of the prior art and its relationship to the appellants' invention. As in all determinations under

35 U.S.C. § 103, the decision maker must bring judgment to bear. It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the appellants' structure as a template and selecting elements from references to fill the gaps. The references themselves must provide some teaching whereby the appellants' combination would have been obvious. In re Gorman, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (citations omitted). That is, something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. See In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

Eweryd's invention relates to a machine for sealing material in sheets, which have been pre-coated with beads of glue affected by heat, preferably electronically printed toner beads, the beads coming into engagement with each other after folding the sheet into such as the configuration of an

envelope or the like, the sheet then being advanced into the machine for adhering the beads to each other. In accordance with Eweryd's invention, the machine includes a first sealing zone 12 and a second

sealing zone 13, which are arranged at 90° to each other with advancing means 36,38,34,47 for conveying the respective sheet through the sealing zones. Each sealing zone has one or more pairs of rotationally driven sealing discs 14,15,18,19,23,26. Each pair of sealing discs includes a first disc 14,15,23 heated by heating means, and a second, preferably freely rotating, disc 18,19,26 engaging against the first disc with a pre-settable pressure. In this way there is heat transfer from the first sealing disc to the second sealing disc so that when a sheet folded to envelope configuration is taken through the machine with the aid of the advancing means, the toner beads situated in an advancing direction are first caused to pass through the first sealing zone and the envelope is then given a new advancing direction at 90° to the previous one, the toner beads in the new direction being caused to pass through the second sealing zone. As shown in Figure 5, the

first sealing zone 12 and the second sealing zone 13 are horizontally offset from one another.

Edin discloses an arrangement for feeding banknotes which includes a gripping means for transferring the notes from one part of a transport path to another part. As shown in Figure 5, the gripping means comprises two mutually co-acting wheels or like elements 171,172, the rotational axes of which are roughly at right angles to the movement direction of the transport path shown by the lower, lefthand arrow, two mutually co-acting rollers or like elements 174,174', the rotational axes of which are substantially parallel with the direction of movement of the transport path, a movable link 173, in which the wheel 171 is journalled, and a bridge element 175 which is movably journalled to the movable link 173 and in which the roller 174 is journalled. At the site of the gripping means 17, the transport path comprises two movable belts 51,52 which lie loosely in abutment with one another and between which documents are transported, either to the refeed or return location 18, or from the upper arrangement part (the processing part) to the lower

arrangement part, in response to the control signals received from a guide and control means 16. When returning documents to

the return location 18, the wheels 171,172 press the belts 51,52 against one another and the rollers 174,174' are located a certain distance apart, and documents are transported in the direction shown by the lower, left-hand arrow. When documents are to be transported to the lower part of the arrangement, the control means 16 sends a signal to a solenoid 53, which attracts the bridge 175 and therewith the link 173, thus breaking the co-action between the wheels 171 and 172. During its movement towards the solenoid 53, the link 173 comes into contact

with a stop 176, whereupon solely the bridge 175 is rotated, to some slight extent, thereby bringing the roller 174 into co-action with the roller 174'. The document located between the rollers at that particular moment will then be transported in a direction at right angles to the belts 51,52, as shown by the bent arrow at the top of Figure 5. Not only is the document transported in a different direction, but it also changes from being transported lengthwise (a short side first) to being transported sideways (a long side first).

Walter discloses a repair inserter sealer. As shown in Figures 1-11, business forms may be manually inserted into cooperation with a conveyor between a folder 11 and a sealer 12 by providing an outer movable cover 18 for the conveyor, and

an inner normally stationary cover 25 underneath the outer cover. A slot 27 is formed in the inner cover, with first and second guide elements 34, 35 extending upwardly and downwardly, respectively, from the slot. Each of the guide elements has a plate, the first guide element having one upstanding guide edge, and the second guide element having adjustably spaced first and second S-shaped guide edges. A planar transition portion of the first guide element overlaps and is connected to the second guide element, and a planar transition portion of the second guide element is connected to the bottom of the inner cover. The second guide element plate makes an angle of between about 30°-60° with respect to the cover plate, and causes inserted forms to pass over some of the rollers of the conveyor directly into association with others.

Kalisiak discloses a system and method for pressure sealing business forms to provide for maximum utilization of floor space and ease of control by an operator. As shown in Figure 1, first and second pressure sealing devices 11, 12, each having upper and lower sets of rollers forming nips for sealing business forms only along strips of pressure sensitive adhesive, are mounted one above the other. A common drive is provided for the drive rollers of each set, for each sealing device. Tape conveyors
assist in conveying the forms through the first sealer, around a horizontal axis large diameter drum, and from the large diameter drum through the second sealer, the forms moving in the opposite
direction to the one they moved in through the first sealer when going through the second sealer. A rotator 14 is provided between the drum and the second sealer for changing the orientation of the forms about 90°. The forms are fed to the first sealer by an infeed conveyor/deshingler 15, and are removed from the second sealer by an outfeed conveyor/stacker 16.

According to the examiner (answer, pp. 4-5) with respect to claim 1 (the sole independent claim on appeal), it would have been obvious to one having ordinary skill in the art to (1) mount Eweryd's right-angle configuration of end and cross-sealers in a vertical plane in view of the teaching of Edwin; (2) substitute pressure sealing rollers for Eweryd's heat sealing rollers;
(3) include a slot chute as the forms are transported in the vertical direction in view of the teachings of Walter; and
(4) include any number of redundant sealing rollers in view of the teachings of Kalisiak.

As set forth above, teachings of references can be combined only if there is some suggestion or incentive to do so. Here,
the prior art contains none. The disparate teachings of the applied prior art and the manner in which they are proposed to be combined indicate, in our view, that the examiner has engaged in an impermissible hindsight reconstruction of the appellants' invention using the claims as a template to selectively piece together isolated disclosures in the prior

art. Even if the Edin reference is considered to be analogous prior art (the appellants argue that it is not), the combined teachings of the applied prior art would not have suggested a vertical pressure sealing assembly as set forth in claim 1.

For the reasons set forth above, the decision of the examiner to reject claims 1 to 3, 5 and 6 under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1 to 3, 5 and 6 under 35 U.S.C. § 103 is reversed.

REVERSED

IAN A. CALVERT Administrative Patent Judge	)	
LAWRENCE J. STAAB Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
JEFFREY V. NASE Administrative Patent Judge	)	

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